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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/874,363 | 06/06/2001 | Toshihiko Kobayashi | FUJI 121 | 2946 |

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| EXAMINER | |
|---|---|
| CHOU, ALBERT T | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2662 | |

DATE MAILED: 05/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/874,363 | KOBAYASHI, TOSHIHIKO | |
| | Examiner | Art Unit | |
| | Albert T. Chou | 2662 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *17 March 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-8* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4* is/are rejected.

7)☒ Claim(s) *5-8* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

### *Response to Amendment*

1. The following is a response to the amendment filed on March 17, 2005.

- Claims 1-8 are pending in the application.
- Claims 1-4 remain rejected under U.S.C. 102(e) as being anticipated by Eloranta (PCT/EP99/01760) as recited in ***Claim Rejections - 35 USC § 102*** below.
- New claims 5-8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-4 are rejected under U.S.C. 102(e) as being anticipated by Eloranta (PCT/EP99/01760; International Publication Number: WO 00/56019; International Publication Date: September 21, 2000).

Regarding claim 1, Eloranta teaches a Gateway GPRS Support Node GGSN **[Fig. 4; a *communication terminal apparatus*]** comprises

Communication control means for receiving a G-PDU data packet from an SGSN to the Internet **[Fig. 4; page 12, lines 6-14; *communication means for controlling communication by said communication terminal apparatus with said another communication terminal apparatus*]**. The intercepted data is transferred via the GPRS tunnel to the IDD/LIG **[Fig. 4; page 12, lines 6-14; *communication means for controlling communication with said communication intercepting apparatus*].**

Eloranta also teaches GGSN receives an interception request from IAD/LIG. In response thereto, IDC/GGSN transmits an activation message comprising the tunnel identification TID and a destination information D comprising IIMSI to IDD/LIG **[Figs. 2 & 4; page 10, lines 1-10; *monitoring request recognizing means for recognizing reception of a monitor request signal from said communication intercepting apparatus*].** If a G-PDU packet relating to the corresponding tunnel TID is then received by the IDC/SSGN, it is collected and transmitted to the IDD/LIG **[Figs. 2 & 4; page 10, lines 13-16; *while said communication terminal apparatus is busy communicating with said another communication terminal apparatus*]**.

Eloranta further teaches that upon receipt an interception request from Interception Activation/Deactivation IAD/LIG **[Figs. 2 & 4; page 10 lines 1-10]**, IDC/GGSN will initiate the interception of data packet originated from SGSN to GGSN (or via GGSN to Internet) **[Figs. 2 & 4; page 12, lines 6-14; *monitoring data generating means for generating monitoring data*]**. The intercepted data packet will

be transferred to the destination in accordance with the Destination Information D in the interception activation message received by GGSN **[Figs. 2 & 4; page 10, lines 1-10; page 12, lines 6-14; *monitoring data generating means for sending said monitoring data to said communication means for transmission to said communication intercepting apparatus*]**.

Regarding claim 2, Eloranta teaches) GGSN receives an interception request from IAD/LIG when the interception function is required **[Figs 2 & 4; page 10, lines 1-10]**. The IAD activates the current interception targets according to information supplied from the IAM/SSGN and commands supplied by a user interface UI in order to change the interception criteria **[Figs 2 & 4; page 7, lines 32-36; *monitoring request signal is received by said receiving means as an option to a recall connect request signal*]**.

Regarding claim 3, Eloranta teaches a Lawful Interception Gateway LIG **[Fig. 4; *a communication intercepting apparatus*]** initiates an interception activation message from the User Interface to IDC/SSGN **[Figs. 2 & 4; page 10, lines 1-6; *communication control means for controlling the transmission of monitor request*]**. In response to the interception activation message, IAD/LIG transmits an interception activation message comprising an activation criterion to IDC/GGSN **[Figs. 2 & 4; page 10, lines 1-6; *to request said communication terminal apparatus to transmit monitoring data while said communication terminal apparatus is busy communicating with said another communication terminal apparatus*]**. The IDD/LIG receives the intercepted data from GGSN **[Figs. 2 & 4; page 10, lines 1-6; *communication control means for controlling the reception of said monitoring data from said***

***communication terminal apparatus***] and transmits it via the User Interface **UI** to the interceptor to which the destination is allocated **[Figs. 2 & 4; page 12, lines 6-18; *monitoring means for reproducing said monitoring data received*]**.

Regarding claim 4, Eloranta teaches the User Interface UI/LIG initiates an interception activation message when the interception function is required **[Fig. 4; *requesting said terminal apparatus to transmit said monitoring data*]**. In response to the interception activation message, the IAD activates the current interception targets according to an information supplied from the IAM/SSGN and commands supplied by a user interface UI in order to change the interception criteria **[Figs 2 & 4; page 7, lines 32-36; *transmits said monitoring request signal as an option added to a recall connect request signal*]**.

### *Response to Arguments*

4. Applicant's arguments filed on March 17, 2005 have been fully considered but they are not persuasive.

With regard to "*GGSN is not a communication terminal apparatus*", applicant admits that "*although the GGSN may appear superficially to have some of functionality of the communication terminal apparatus recited in claim 1*". As shown in Fig. 4, Eloranta teaches GGSN is a communication end apparatus or edge apparatus, which connects to a packet switched network, such as Internet, and allows data which transmitted and received to/from another communication terminal apparatus (e.g. SGSN) to be monitored by a communication intercepting apparatus (e.g. LIG). GGSN

meets all limitations recited in the preamble of claim 1. Furthermore, Eloranta discloses that the invention is not limited to the described GPRS network and can be used in any packet network using a subscriber identity for creating a subscriber (or terminal) connection **[Page 13, lines 1-9].**

With regarding to "*Eloranta fails to disclose a monitor request recognizing means for recognizing reception/non-reception of a monitor request signal from said communication intercepting apparatus while said communication terminal apparatus is busy communicating with said another communication terminal apparatus (emphasis added), as amended claim 1 requires*", Eloranta teaches the IAD/LIG transmits an interception activation message comprising an activation criterion and the allocated IIMSI to IDC/GGSM **[Page 10, lines 4-6]**. In response to the interception activation message from IAD/LIG, the IDC/SSGN transmits an activation message comprising the tunnel identification TID and a destination information D comprising the IIMSI to the IDD/LIG, for each tunnel with identifier TID where criterion matches the TID. **[Page 10, lines 6-10].** In other words, IDG/SSGN would not perform the interception activation request from IDA/LIG **[*for recognizing reception/non-reception of a monitor request signal from said communication intercepting apparatus*]** or transmit any collected data to IDD/LIG if no TID matches the matches the criterion in the interception activation message [**regardless *said communication terminal apparatus is busy communicating with said another communication terminal apparatus* or not**].

With regard to "*no disclosure in Eloranta regarding the detailed nature of the interception request signal send from the IAD to GGSN, and certainly no suggestion*

*that the monitoring request signal in Eloranta is specifically an option that is added to the standard recall connect request signal used in a packet network*", Eloranta teaches GGSN receives an interception request from IAD/LIG when the interception function is required. The IAD activates the current interception targets according to information supplied from the IAM/SSGN and commands supplied by a user interface UI in order to change the interception criteria **[Figs 2 & 4; page 7, lines 32-36; *an option that is added to the standard recall connect request signal used in a packet network*]**.

***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Albert T. Chou whose telephone number is 571-272-6045. The examiner can normally be reached on 8:30 - 17:00. If attempts to reach the

examiner by telephone are unsuccessful, the examiner's supervisor, Hassan Kizou can be reached on 571-272-3088. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AC
Albert T. Chou
May 17, 2005

HASSAN KIZOU
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